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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,951	11/08/2006	Franz jun. Neuhofer	NEUHOFFER, JR.-16 PCT	3739
25889	7590	08/30/2011		
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER TRIGGS, ANDREW J	
			ART UNIT	PAPER NUMBER
			3635	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,951	Applicant(s) NEUHOFFER, FRANZ JUN.	
	Examiner ANDREW TRIGGS	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 2-6, 8 and 10-12 is/are pending in the application.
- 5a) Of the above claim(s) 8 and 11 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 2-4, 10 and 12 is/are rejected.
- 8) ☒ Claim(s) 5 and 6 is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse is acknowledged. The traversal is on the ground(s) that the Applicant has already received numerous actions examining both types of inventions. This is not found persuasive because the previous method claims were generic to the device. With the present state of claims, the method is independent and distinct.

The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

2. Applicant's arguments/amendments with respect to the 112 rejections have been fully considered and are persuasive. The 35 USC 112 1st paragraph rejection of Claims 10 and 12 have been withdrawn.

3. Applicant's arguments with respect to the rejection(s) of claim(s) 10 and 12 under the case law of *In Re Einstein* have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the obviousness of Stanchfield alone.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

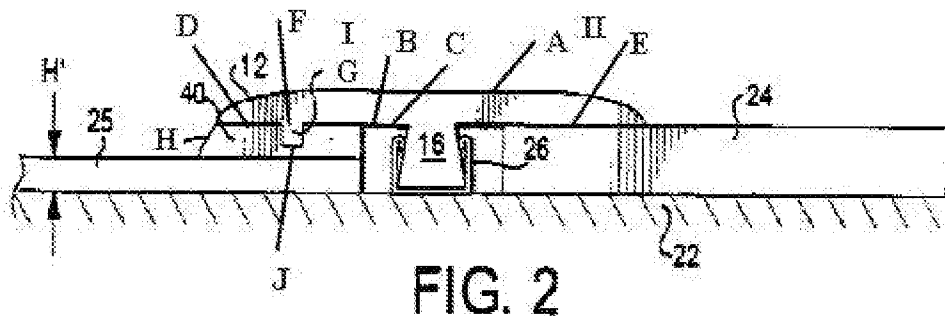
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5. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent # 6,860,074 to Stanchfield.

Regarding claim 10, Stanchfield teaches a covering device for joints in panels such as floor panels (Abstract). Stanchfield teaches that the cover can be made of plastic based products, such as PVC (Columns 4, Lines 50-51). These types of materials are commonly formed by extruding them through a machine to create the desired profile. Stanchfield teaches, in Figure 2 [annotated below], the cover (A) has a covering flange (B) and a clamping web (16) that protrudes downward from the covering flange (B) and extends in a longitudinal direction along the cover (A). The covering flange (B) comprises an underside (C) comprising a first contact surface (D), a second contact surface (E), a longitudinal tongue section (F) with a longitudinal tongue (G) in the tongue section (F) in the first contact surface (D) extending past the clamping web (16) on a first side (I) of the profiled cover (A) and the second contact surface (E) extends past the clamping web (16) on a second side (II) of the profiled cover (A); a compensating strip (H) comprises a groove (J) and is fastened to the covering flange. The tongue (G) of the profiled cover (A) and the groove (J) of the compensating strip (H) form a tongue-and-groove joint fastening the compensating strip (H) to the covering flange (B) as the tongue (G) projects into the groove (J) and the groove (J) retains the tongue (G). The tongue section (F) is supported flat over the compensating strip (H), the first contact surface (D) is supported flat over the compensating strip (H) and the second contact surface (E) is supported flat over

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a floor cover segment (24). Stanchfield teaches a tongue section where the claimed groove section is, a tongue where the claimed groove is and a groove where the claimed tongue is. However, it would have been obvious to one of ordinary skill in the art to reverse the positions of the tongue and groove as seen in Figure 18 where a compensating strip (210) has a tongue (218) and a portion of the cover (11) has the groove (219) since it is easier to extrude the cover with a groove rather than a tongue and the compensating strip can be machined on both sides to create the tongue. Also the tongue made of wood would be stronger than an extruded tongue on the cover.



Regarding claim 12, Stanchfield teaches a covering device for joints in panels such as floor panels (Abstract). Stanchfield teaches that the cover can be made of plastic based products, such as PVC (Columns 4, Lines 50-51). These types of materials are commonly formed by extruding them through a machine to create the desired profile. Stanchfield teaches, in Figure 2 [annotated above], the cover (A) has a covering flange (B) and a clamping web (16) that protrudes downward from the covering flange (B) and extends in a longitudinal direction along the cover (A). The covering flange (B) comprises an underside (C) comprising a first

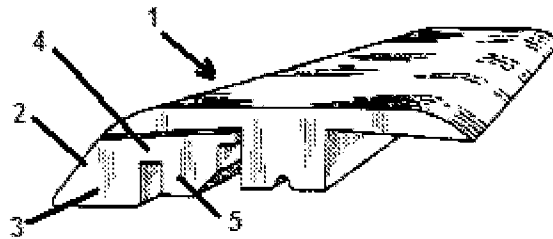
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contact surface (D), a second contact surface (E), a longitudinal tongue section (F) with a longitudinal tongue (G) in the tongue section (F) in the first contact surface (D) extending past the clamping web (16) on a first side (I) of the profiled cover (A) and the second contact surface (E) extends past the clamping web (16) on a second side (II) of the profiled cover (A); the tongue (G) of the cover (A) can be received in a groove (J) on a compensating strip (H) to form a tongue-and-groove joint fastening the compensating strip (H) to the covering flange (B) as the tongue (G) projects into the groove (J) and the groove (J) retains the tongue (G). The tongue section (F) is supported flat over the compensating strip (H), the first contact surface (D) is supported flat over the compensating strip (H) and the second contact surface (E) is supported flat over a floor cover segment (24). Stanchfield teaches a tongue section where the claimed groove section is, a tongue where the claimed groove is and a groove where the claimed tongue is. However, it would have been obvious to one of ordinary skill in the art to reverse the positions of the tongue and groove as seen in Figure 18 where a compensating strip (210) has a tongue (218) and a portion of the cover (11) has the groove (219) since it is easier to extrude the cover with a groove rather than a tongue and the compensating strip can be machined on both sides to create the tongue. Also the tongue made of wood would be stronger than an extruded tongue on the cover.

6. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074 in view of Neuhofer, US Design Patent # D542,941.

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Regarding claim 2, Stanchfield teaches a covering device with a compensating strip that has a tongue and groove connecting mechanism but does not teach the compensating strip has two legs. However, Neuhofer teaches in the annotated figure below, a covering device (1) with a compensating strip (2) that has a basic form of an angle and two legs (3 and 4). In combination with Stanchfield, leg (4) would have the tongue and groove mechanism on it. Furthermore, it can be seen that the compensating strip (2) makes an extension of the cover (1) extending downward. One of ordinary skill in the art at the time of the invention would have been motivated to have a compensating strip with two legs because the legs form a continuation of the covering device that creates a smooth even flowing cover over a gap between panels. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.



Regarding claim 3, Stanchfield teaches a compensating strip but does not teach a supporting leg connected to the leg that has the tongue and groove mechanism. However, Neuhofer teaches in the annotated figure above, that the compensating strip (2) has a supporting leg (5) projecting from leg (4). In combination with Stanchfield, leg (4) would have the tongue and groove mechanism on it. One of ordinary skill in the art at the time of the invention would

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have been motivated to further include a supporting leg because a groove between the supporting leg and other leg can be used to secure the compensating strip securely. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074 in view of Neuhofer, US Design Patent # D542,941 in further view of Kemper, US Patent # 6,345,480.

Regarding claim 4, Stanchfield in view of Neuhofer teach a cover device that has a supporting leg on the compensating strip. It can be seen in Figure 1 of Neuhofer that there is a channel between the legs that is capable of accepting a fixture from the profile cover but Stanchfield only teaches one securing means (26) on the fixture. However, Kemper teaches the use of two securing means (6 and 12) on the fixture (3). One of ordinary skill in the art at the time of the invention would have been motivated to include two or more securing means on the floor mounting plate fixture in order to secure not only the covering device but also the compensating strip to the floor. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

Allowable Subject Matter

8. Claims 5 and 6 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW TRIGGS whose telephone number is (571)270-3657. The examiner can normally be reached on Monday through Thursday 6:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William V Gilbert/
Examiner, Art Unit 3635

/Andrew J Triggs/
Examiner, Art Unit 3635